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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER DAM NIELSEN and CHRISTIAN KRAFT

Appeal 2009-001180¹
Application 09/833,607
Technology Center 2100

Decided: October 14, 2009

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and JAY P.
LUCAS, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 10 through 30. Claims 1 through 9 and 31 through 33 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Filed April 13, 2001. The real party in interest is Nokia Mobile Phones, LTD.

We reverse.

Appellants' Invention

Appellants invented a method and system for displaying text which exceeds the width of a mobile terminal display. As shown in Figure 2, the terminal display provides a user with a menu of options (170) for displaying an item either in a continuous length format (190) as a single line or in a wrapped length format (185) as multiple lines thereby allowing the user to toggle between the two formats, and to subsequently display the item according to the user's selection. (Spec. 3, ll. 9-18.)

Illustrative Claim

Independent claim 10 further illustrates the invention. It reads as follows:

10. A method for displaying information on a mobile terminal display via a browser, said information including elements, wherein an element is one of a continuous length element presenting a length which is equal to or greater than a horizontal size of the mobile terminal display, and a wrapped length element presenting a horizontal length which is less than the horizontal size of the mobile terminal display, and the mobile terminal display is further provided with a user interface including a displayed menu structure of items displayed on the mobile terminal display, said method comprising the following steps: providing in said displayed menu structure a selectable continuous length item and a wrapped length item which are chosen from the mobile terminal display as display options;

selecting one of said continuous length item and said wrapped length item in the displayed menu structure of the user interface; and

displaying said information according to the selection of the display option made in the menu structure of the user interface, in order to allow a user to toggle between the continuous length item and the wrapped length item,

wherein selection of the continuous length item causes the element to be displayed as the continuous length element on a single line of the mobile terminal display and selection of the wrapped length item causes the wrapped length element to be displayed on a plurality of lines of the mobile terminal display.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Schwartz US 6,209,009 B1 Mar. 27, 2001

Gabriele Wentges, *Up & Running with Windows 3.0*, Sybex Inc., 51-55 (1990).

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 10 through 30 stand rejected as being unpatentable over Schwartz.

Appellants' Contentions

Appellants contend that Schwartz does not teach (1) providing a display menu having a selectable continuous length item and a wrapped length item as display options and (2) allowing a user to toggle between the

continuous and wrapped items in order to display the selected item in a corresponding fashion, as recited in independent claim 1. (App. Br. 5-7, Reply Br. 2-4.) According to Appellants, while Schwartz discloses displaying an item in a continuous length fashion or in a wrapped length fashion as alternative solutions for displaying text which exceeds the width of a display, the reference does not disclose such elements as being parts of a single menu structure from which a user can select a desired format or toggle between the formats to subsequently display the selected item in a corresponding manner. (*Id.*) Appellants further argue that the Examiner failed to establish a proper prima facie case of obviousness. (App. Br. 7-9, Reply Br. 4-5.) Additionally, Appellants argue that Schwartz teaches away from the claimed invention. (App Br. 9-10, Reply Br. 5.)

Examiner's Findings

The Examiner finds that Schwartz discloses a continuous length format and a wrapped length format as two separate alternatives for displaying text which exceeds the width of a screen display. (Ans. 10, 12.) The Examiner further finds that Schwartz teaches a display menu having a plurality of display options from which a user is able to select a desired display format, as well as toggle between them. (*Id.* at 10.) Additionally, the Examiner finds that selecting between different menu options and

toggling between them is a well-known practice in the art.² (*Id.* at 9.) The Examiner thus concludes that it would have been obvious to one of ordinary skill in the art to include the two disclosed display formats as display options in Schwartz's menu. (*Id.* at 9-12.)

II. ISSUE

Have Appellants shown that the Examiner erred in concluding that one of ordinary skill would have found sufficient rationale to incorporate Schwartz's continuous length item and a wrapped length item as display options in the menu of the small screen display to thereby allow a user to toggle between the formatted items and to subsequently display the selected item in a corresponding fashion.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Schwartz

1. As shown in Figures 1A through 3D, Schwartz discloses a menu having a plurality of choices for displaying text which exceeds the width of a small screen display. Further, Schwartz discloses conventional

² The Examiner cites to Wentges as evidence that such practice is well-known in the art. (Ans. 2, 9.)

alternatives solutions for displaying text on the small screen display. (Col. 1, ll. 38-41.)

2a. A first conventional solution consists in wrapping the length of the text to thereby display it on the screen as multiple lines. (Col. 1, ll. 42-50.)

2b. A second conventional solution consists in displaying the text in a continuous length format by displaying the text as a single line. (Col. 2, ll. 8-15.)

2c. A third conventional solution consists in displaying the text in a hybrid format which combines the wrap length format and the continuous length format. (Col. 2, ll. 19-25.)

3. Schwartz discusses that the conventional solutions do not allow a user to view all the menu options at a glance. Consequently, Schwartz discloses a method for displaying a portion of each option in the menu to enable the user to dynamically select a desired option. (Col. 3, ll. 9-22.)

IV. PRINCIPLES OF LAW

Obviousness

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary

indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

V. ANALYSIS

Independent claim 10 requires, in relevant part, (1) providing a display menu having a selectable continuous length item and a wrapped length item as display options and (2) allowing a user to toggle between the continuous and wrapped items in order to display the selected item in a corresponding fashion. As set forth in the Findings of Fact section, Schwartz discloses a continuous length format and wrapped length format as alternatives for displaying text that exceeds the width of a small screen display. (FF. 2a-2c.) Further, Schwartz discloses a menu of options displayed on a small screen from which a user may select a desired text entry for display on the small screen. (FF. 1.) While Schwartz generally discloses the continuous length and the wrapped length display formats, we find that these alternative formats are disclosed as being parts of separate and distinct display systems, and not as options in a single menu that allows a user to readily select a desired mode or format. Further, we find that even if the separate systems that embody the different display formats of the prior art were brought together, the resulting system would not necessarily yield a single menu with the two modes being displayed as options, let alone providing a mechanism for toggling between the two display modes. Thus, while the ordinarily skilled artisan being presented with Schwartz’s menu of

options would be free to display the different choices of text in a previously selected format, the artisan would not be able to readily switch or toggle from one format to another, as required by Appellants' claim. Consequently, it would not be reasonable for the artisan to expect a user of Schwartz's system to be able toggle or readily switch between the two disclosed display formats. Additionally, we find deficiency in the Examiner's reliance on Wentges in the Examiner's Answer to show that toggling between different modes is well-known in the art. It has been held that where a reference is relied upon to support a rejection, even a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection. *In re Hoch*, 428 F.2d 1341, 1342 (CCPA 1970). Consequently, we find that Wentges cannot be properly relied upon to cure the deficiencies of Schwartz.

Since Appellants have shown at least one error in the rejection of claim 10, we need not reach the merits of Appellants' other arguments. It follows that Appellants have shown that the Examiner erred in concluding that Schwartz renders independent claim 10 unpatentable.

Because claims 11 through 30 also recite the limitations discussed above, we find that Appellants have also shown error in the Examiner's rejection of these claims for the reasons set forth in our discussion of independent claim 10.

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VI. CONCLUSION OF LAW

Appellants have established that the Examiner erred in rejecting claims 10 through 30 as being unpatentable under 35 U.S.C. § 103(a).

VIII. DECISION

We reverse the Examiner's rejection of claims 10 through 30.

REVERSED

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